

REMARKS

Introduction

Claims 1-32 and 65-84 were pending in this application.

Applicant has amended claims 1 and 11 to more particularly define the invention. Applicant has amended claim 27 to correct a minor clerical error. Applicant has cancelled claims 65-84 without prejudice. No new matter has been added and the amendments and new claims are fully supported and justified by the specification.

Reconsideration of this application in light of the following remarks is hereby respectfully requested.

Summary of the Office Action

Claims 1 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dickinson et al., G.B. Patent No. 2,147,773 (hereinafter "Dickinson") in view of Sarno, U.S. Patent No. 6,024,641 (hereinafter "Sarno") in view of Tso et al., U.S. Patent No. 6,047,326 (hereinafter "Tso") .

Claims 2-5, 7, 9, 12-15, 17, 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dickinson in view of Sarno in view of LottoBot, <http://lotobot.net> (hereinafter "LottoBot") .

Claims 6 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dickinson in view of Sarno, in view of Tso, and in view of Luciano et al., U.S. Patent No. 6,168,521 (hereinafter "Luciano").

Claims 8 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dickinson in view of Sarno, in view of Tso, and in view of SGI Insights, Scientific Gaming International, vol. 1, issue no. 5 (January 1999) (hereinafter "SGI").

Claims 10 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dickinson in view of Sarno, in view of Tso, and in view of McCollom et al., U.S. Patent Application Publication No. 2002/001623 A1 (hereinafter "McCollum").

Claims 21-32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker et al., U.S. Patent No. 6,325,716 B1 (hereinafter "Walker") in view of Archer, U.S. Patent No. 6,277,026 (hereinafter "Archer").

Summary of Telephonic Interview

The Examiner and applicants' representatives conducted a personal interview on March 31, 2005. Applicant and applicant's representatives wish to thank the Examiner for the courtesies extended during the interview. During the

interview, applicants' representatives and the Examiner discussed the pending Office Action, the rejection of independent claims 1 and 21, and the references cited in the Office Action. No agreement was reached between applicants' representatives and the Examiner.

Applicant's Reply to the Rejection of
Claims 1 and 11 Under 35 U.S.C. § 103(a)

Claims 1 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dickinson, in view of Sarno, in view of Tso. The Examiner's rejections are respectfully traversed.

Applicant's invention, as defined by amended independent claims 1 and 11, is directed toward a method and system for allowing a user in a particular location to participate in lottery wagering using user equipment. An interactive wagering application determines the location of the user and visually displays a listing of lotteries in which the user may participate on the user equipment based on the particular location of the user. The interactive wagering application gives the user the ability to participate in at least one of the lotteries. The user, for example, may be presented with only a listing of lotteries which may legally be played from the user's location (i.e., a

particular state lottery that is only allowed to be played within the state with which the lottery is associated).

Dickinson refers to a lottery game terminal that provides a plurality of user selectable lottery games and is capable of operating in a multi-terminal statewide lottery game system. The game terminal of Dickinson does not determine the location of the game terminal and the plurality of user selectable games available to a player do not depend on the particular location of the terminal.

Sarno refers to a lottery gaming system in which a user may remotely participate in a remote lottery drawing via a network or by some other remote means. The winning lottery numbers are determined by "objective and verifiable elements, such as, for example, a portion of the closing stock market price on a given day for a specified set of markets." Sarno, column 3, lines 6-10. The advantage of this system is that the users can be confident that the winning combination is not "rigged" by the provider. Id.

Tso refers to a system for distributing electronic information to a targeted group of users. For example, information providers may have the "ability to 'focus' the dissemination of information . . . to only send information to users who might be interested in that information." Tso, column 1, lines 58-61. What information is sent to the user

may depend on various factors, such as, the location of the user, the time of day, and the information contained in the viewer profile.

The Examiner asserts that Dickinson teaches all of the features of applicant's independent claims, except using user equipment and limiting the list of lotteries based on the user's location.¹ The Examiner attempts to remedy these deficiencies in Dickinson by combining Dickinson with Sarno and Tso.

I. THE CITED REFERENCES DO NOT SHOW OR SUGGEST ALL OF THE ELEMENTS OF APPLICANT'S CLAIMS

Applicant respectfully submits that nothing in either Dickinson or Sarno or Tso shows or suggests a lottery system that determines the location of the user and provides a listing of lotteries in which the user can participate on a visual display based on the particular location of the user. Therefore, whether taken alone or in combination, Dickinson, Sarno, and Itoh fail to show all of the features of applicant's invention as defined by amended independent claims 1 and 11.

¹ The Examiner "interprets 'user equipment' to mean equipment that is the possession of [a] player (e.g. owner or leased) rather than owner or operated by [a] game vendor." Office Action, page 2. Applicant does not agree with the Examiner's definition of user equipment and expressly reserves the right to present an alternative definition at a later time, if necessary.

II. THE EXAMINER HAS FAILED TO MAKE OUT
A *PRIMA FACIE* CASE OF OBVIOUSNESS

In order to establish a *prima facie* case of obviousness based on a combination of references, there must be "some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP, at § 2143.01. Applicant respectfully submits that the Examiner has failed to fulfill the requirement of presenting an "objective teaching . . . or . . . knowledge generally available to one of ordinary skill in the art that would lead that individual to combine the relevant teachings of the references," In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). See In re Rouffet, 149 F.3d 1350, 1355 ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"). In order to establish a *prima facie* case of obviousness based on a combination of references, there must be "some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP, at § 2143.01.

III. THE EXAMINER HAS FAILED TO PROVIDE MOTIVATION
TO COMBINE THE REFERENCES AND THE REFERENCES
"TEACH AWAY" FROM SUCH A COMBINATION

"Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence' of a motivation to combine. In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), abrogated on other grounds by In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

Applicant respectfully submits that the Examiner has merely listed the alleged benefit of each of the references as motivation to combine instead of pointing to an objective teaching in Dickinson, Sarno, or Tso that would lead one of ordinary skill in the art to combine these three references.

The Combination of Dickinson and Sarno

In support of the combination of Dickinson with Sarno, the Examiner states that:

[A]llowing players to participate in lotteries from their homes using user equipment offers several benefits including (i) increasing lottery revenues by allowing participation by remotely located players, (ii) providing lotteries access to players who cannot afford to travel to jurisdictions that allow lotteries, (iii) enhancing convenience and ease of access, and (iv) offering the potential for enormous winnings. Office Action, page 2 (citing Sarno).

Applicant respectfully submits that none of these alleged benefits of Sarno are actually motivations to combine Dickenson with Sarno. Rather these are a list

of the alleged benefits of on-line gaming systems using user-equipment over traditional lottery arrangements.

However, Dickinson is not a traditional lottery system. Dickinson refers to a specialized lottery terminal for inclusion in a statewide lottery system which alleges its own benefits over traditional lottery arrangements, such as, for example:

(i) providing a plurality of selectable games designed to maintain player interest, (ii) appealing to a broader player base, (iii) enhancing player enjoyment, and (iv) providing a high measure of security. See Dickinson, page 1, lines 45-52.

The Examiner has not provided an objective teaching to combine the specialized lottery terminal of Dickinson and with Sarno. While both of these systems assert benefits that they provide over traditional lottery arrangements, these benefits are not objective teachings to support a claim that the particular feature of user equipment in Sarno may provide benefits to the system of Dickinson.

Further, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984). Dickinson relates to a secure lottery system using a specialized lottery game terminal.

The terminal is specially designed, physically and logically, for its intended purpose and thus teaches away from being substituted with standard insecure user equipment. Thus, because the use of user equipment with Dickinson would make Dickinson unsatisfactory for use in a secure lottery system, there is no motivation to combine Dickinson with Sarno.

The Combination of Dickinson and Tso

In support of the combination of Dickinson with Tso, the Examiner states that this modification "would enhance the system for users by freeing them from the burden of determining which information is relevant to them." Office Action, page 3. Here too, the Examiner has stated an alleged benefit of Tso, but not an objective teaching to combine the features of Tso with Dickinson.

Dickinson does not provide users with large quantities of information that requires "determining which information is relevant." Therefore there is no benefit and thus no motivation to add this feature of Tso to the system of Dickinson. In fact, one of the features of Dickinson is "provid[ing] the game player with a plurality of selectable games." Dickinson, page 1, lines 46-47. The plurality of games in Dickinson is a benefit, not a burden.

There is nothing in Dickinson to show or suggest that player may not be able to play all of the different

games provided on the lottery terminal, therefore there is no reason to limit the listing of games as suggested by the Examiner.

Further, the lottery game terminal of Dickinson is not a portable device. Therefore there is no reason for the system of Dickinson to determine the location of the user and no reason to limit the listing of games based on location.

Moreover, Tso refers to a system for distributing electronic information. Tso does not relate to lottery systems or any sort of wagering or gaming systems. Thus, there is nothing in Tso to suggest combining Tso with the lottery terminal of Dickinson.

Accordingly, for at least these reasons, there is no motivation to combine Dickinson with Tso.

IV. THE EXAMINER HAS EMPLOYED HINDSIGHT RECONSTRUCTION IN COMBINING THE REFERENCES

Applicant respectfully submits that the Examiner has employed hindsight reconstruction in combining the references. With the knowledge of applicant's novel system for allowing a user in a particular location to participate in lottery wagering using user equipment, particular features of the prior art were identified for use in rejecting applicant's invention. This technique has long been held invalid by the courts at creating a *prima facie* case of obviousness. See In re Fine, 5 USPQ2d at 1600. ("One cannot

use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.").

The Examiner has used applicant's own invention as a bridge between Dickinson, Sarno and Tso. In doing so, the Examiner has demonstrated mere hindsight reconstruction, the very "syndrome" that the requirement for objective evidence is designed to combat, and the rejection is therefore insufficient as a matter of law. See In re Dembiczak, 50 USPQ2d at 1617-1618.

V. CONCLUSION

Accordingly, applicant's amended claims 1 and 11 are allowable over Dickinson, in view of Sarno, in view of Tso. Applicant respectfully requests that the rejection of claims 1 and 11 be withdrawn.

Applicant's Reply to the Rejection of Claims 21 and 27 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 21 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Archer. The Examiner's rejections are respectfully traversed.

Applicant's invention, as defined by independent claims 21 and 27, is directed towards a method and system for using an interactive wagering application to allow a user to

participate in a lottery automatically. The user is given the ability to specify conditions under which he wishes to participate in the lottery via the electronic user equipment on which the interactive wagering application is at least partially implemented (i.e., by directly entering the conditions into the electronic user equipment). The interactive wagering application automatically participates in the lottery on behalf of the user when the conditions are met.

Walker refers to a lottery system in which a user must purchase tickets from a lottery agent. After entering necessary information (i.e., lottery numbers and conditions for participating) on a slip of paper by hand, the user must present the slip to a lottery agent who must then scan the slip into his lottery terminal in order to issue and print lottery tickets.

Archer refers to a system for facilitating the purchase and sale of lottery tickets online.

The Examiner asserts that "in view of Archer it would have been obvious to an artisan at the time of the invention to modify Walker, wherein users submit lottery entries using paper ticket, to instead use electronic user equipment." Office Action at pages 7-8.

I. THE EXAMINER HAS FAILED TO MAKE OUT
A *PRIMA FACIE* CASE OF OBVIOUSNESS

Applicant respectfully submits that the Examiner has failed to make out a *prima facie* case of obviousness required to support a rejection under 35 U.S.C. § 103(a). In order to establish a *prima facie* case of obviousness based on a combination of references, there must be "some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP, at § 2143.01. Applicant respectfully submits that the Examiner has failed to fulfill the requirement of presenting an "objective teaching . . . or . . . knowledge generally available to one of ordinary skill in the art that would lead that individual to combine the relevant teachings of the references," In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). See In re Rouffet, 149 F.3d 1350, 1355 ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"). In order to establish a *prima facie* case of obviousness based on a combination of references, there must be "some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally

available to one of ordinary skill in the art." MPEP, at § 2143.01.

II. THE EXAMINER HAS FAILED TO PROVIDE MOTIVATION TO COMBINE THE REFERENCES

Applicant respectfully submits that the Examiner is merely making a broad conclusory statement, and fails to point to any objective teaching by either Walker or Archer that would lead one of ordinary skill in the art to combine the references. Such "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'" of a motivation to combine. In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), abrogated on other grounds by In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

Instead of providing an objective teaching of a motivation to combine Walker and Archer, the Examiner merely concludes that it would have been obvious to combine Walker and Archer because the sale and distribution of lottery tickets online would "enhance revenues." Office Action, page 8. The fact that adding a feature may make the system more profitable is not an objective teaching that would lead one of ordinary skill in the art to combine the references to obtain applicant's invention.

III. THE EXAMINER HAS EMPLOYED HINDSIGHT
RECONSTRUCTION IN COMBINING THE REFERENCES

Applicant respectfully submits that the Examiner has employed hindsight reconstruction in combining the references. With the knowledge of applicant's novel system for allowing a user to participate in a lottery automatically using electronic user equipment, particular features of the prior art were identified for use in rejecting applicant's invention. This technique has long been held invalid by the courts at creating a *prima facie* case of obviousness. See In re Fine, 5 USPQ2d at 1600. ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.").

The Examiner has used applicant's own invention as a bridge between Walker and Archer. In doing so, the Examiner has demonstrated mere hindsight reconstruction, the very "syndrome" that the requirement for objective evidence is designed to combat, and the rejection is therefore insufficient as a matter of law. See In re Dembicza, 50 USPQ2d at 1617-1618.

Because the Examiner failed to point to a suggestion or motivation for modifying Walker with the teachings of Archer, applicant respectfully submits that the Examiner has failed to make a *prima facie* case of obviousness. MPEP, at § 2142.

V. CONCLUSION

Accordingly, for at least the above reason, applicant's independent claims 21 and 27 are allowable. Applicant respectfully requests that the rejection of claims 21 and 27 be withdrawn.

Applicant's Reply to the Rejection of Claims 2-10, 12-20, 22-26, and 28-32 Under 35 U.S.C. § 103(a)

Claims 2-10 and 12-20 are allowable at least because they depend from allowable independent claims 1 and 11. Applicant respectfully requests that the rejection of claims 2-10 and 12-20 be withdrawn.

Claims 22-26 and 28-32 are allowable at least because they depend from allowable independent claims 21 and 27. Applicant respectfully requests that the rejection of claims 22-26 and 28-32 be withdrawn.

Conclusion

For at least the foregoing reasons, applicant respectfully submits that this application is in condition for allowance.

Accordingly, prompt reconsideration and allowance
of this application are respectfully requested.

Respectfully submitted,



Alexander Shvarts
Registration No. 47,943
Attorney for Applicant
FISH & NEAVE IP GROUP
ROPES & GRAY LLP
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020-1105
(212) 596-9000